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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO. <i>7</i>
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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED: *9*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/360,947**

Applicant(s)  
**Sumner, C.**

Examiner  
**Joseph Murray**

Group Art Unit  
**1626**



X Responsive to communication(s) filed on Oct 6, 1900

X This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

X Claim(s) 1-47 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

X Claim(s) 1-47 is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

☐ Claims \_\_\_\_\_

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

X Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claims 1-47 are pending in the instant application.

***Double Patenting***

Claims 1-47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-67 of copending Application No. 09/237384, and claims 1-60 of copending application 09/237406. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the instant application claims the separation of a tocolpherol from a tocolpherol admixture the tocolpherol generic form of the compound, and the copending application claims the separation of a tocotrienol, or tocol from a tocol mixture, which is an isomeric/unsaturated form of the tocols. The only difference of the instant application from the copending applications is the desired product of the separation process, all being within the same class of compound, e.g alkyl/alkenyl substituted hydroxy-benzopyrans. Therefor one of ordinary skill in the art would have been motivated to apply the instantly claimed invention to the other isomers of the tocols. Thus it would have been obvious to one of ordinary skill in the art to apply the method of separation in copending application 09/237384, and 09/237406 to the tocol separation by only modifying the extraction solvent selection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

This rejection is maintained for the reasons of record as set forth in paper no. 3.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-47 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 09/237,406 which has a common inventor, e.g. Charles E. Sumner Jr., with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future patenting of the conflicting application. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the instant application claims the separation of a tocolpherol from a tocolpherol admixture the tocolpherol generic form of the compound, and the copending application claims the separation of a tocotrienol, or tocol from a tocol mixture, which is an isomeric/unsaturated form of the tocols. The only difference of the instant application from the copending applications is the desired product of the separation process, all being within the same class of compound, e.g alkyl/alkenyl substituted hydroxy-benzopyrans. Therefor one of ordinary skill in the art would have been motivated to apply the instantly claimed invention to the other isomers of the tocols. Thus it would have been obvious to one of ordinary skill in the art to

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apply the method of separation in copending application 09/237384, and 09/237406 to the total separation by only modifying the extraction solvent selection.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(f) he did not himself invent the subject matter sought to be patented.

Claims 1-47 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Although the instantly claimed applicant is a named inventor in the other two(2) copending applications, 09/237,406, and 09/ 237,384, there are several other inventors in the copending applications, which have rights to the instantly claimed invention.

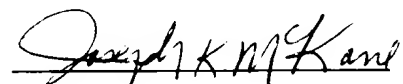
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Joseph Murray whose telephone number is (703) 308-4540. The examiner can normally be reached from 7:30 to 4:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537. The fax phone number for this group is (703) 308-4556.



Joseph McKane  
Supervising Patent Examiner  
Art Unit 1626

Joseph Murray  
November 15, 2000